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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,656	07/24/2001	Atsushi Akiyama	01439/LH	3827

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EXAMINER

LETT, THOMAS J

ART UNIT PAPER NUMBER

2626

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/911,656	AKIYAMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas J. Lett	2626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7 and 9 is/are rejected.
- 7) ☐ Claim(s) 3,6 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claim 7 is objected to because of the following informalities: a period should be placed after the term "completed" (p.29, line 19). Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4, 5, 7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Maeda (US Patent 6,690,480 B2).

With respect to claim 1, Maeda discloses a facsimile apparatus (Internet facsimile apparatus 1) for allowing facsimile communications through a computer network (Internet 4), comprising:

a storage section (RAM 12, see Fig. 1);

an address acquisition section (a RAM 12 that stores destination addresses, col. 9, lines 63-64) configured to acquire an address of other party of the facsimile communications during the facsimile communications (facsimile apparatus 1 exchanges

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Internet addresses with a communication partner in the G3 facsimile mode, col. 1, lines 41-42);

an address storage control section (destination table (Fig. 3)) configured to store the address acquired by the address acquisition section in the storage section at least when the address is not stored in the storage section; and

an address designation section (CPU 5 accesses control data and destination data stored in RAM 12) configured to designate an address selectively from addresses stored in the storage section when the other party of the facsimile communications is designated and setting the designated address as an address of the other party.

With respect to claim 2, Maeda discloses that the address storage control section (destination table (Fig. 3)) stores the address acquired by the address acquisition section in the storage section only when the address is not stored in the storage section. Examiner notes that the address data would be stored if the data were not present.

With respect to claim 4, Maeda discloses that the apparatus has a simple address designating function (one-touch dial) of designating an address of the other party of the facsimile communications by a simple operation, and the apparatus further comprises an address registering section configured to register the designated address as an address for the simple address designating function (destination data contains an Internet address of a corresponding one-touch dial, col. 5, lines 32-34).

With respect to claim 5, Maeda discloses a communication-capability acquisition section (a RAM 12 that stores the presence/absence of G3 FAX function or Internet

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FAX function, col. 10, lines 27-29) configured to acquire communication-capability information of the other party during the facsimile communications; and

a communication-capability storage control section (a RAM 12 that stores the presence/absence of G3 FAX function or Internet FAX function, col. 10, lines 27-29) configured to store the communication-capability information acquired by the communication-capability acquisition section in the storage section in correspondence with the address acquired by the address acquisition section.

With respect to claim 7, Maeda discloses a communication-capability storage control section configured to store communication-capability information in the storage section (a RAM 12 that stores the presence/absence of G3 FAX function or Internet FAX function, col. 10, lines 27-29) in correspondence with the address of the other party (see Fig. 3), the communication-capability information corresponding to communication capability including in affirmation information transmitted from the other party of the facsimile communications after the facsimile communications are completed.

With respect to claim 9, Maeda discloses method of controlling a facsimile apparatus (Internet facsimile apparatus 1 using CPU 5) having a storage section (RAM 12) and capable of facsimile communications through a computer network (see Fig. 1), comprising:

an address acquisition step of acquiring an address of other party of the facsimile communications during the facsimile communications (facsimile apparatus 1 exchanges Internet addresses with a communication partner in the G3 facsimile mode, col. 1, lines 41-42);

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an address storage control step of storing at least the address acquired in the address acquisition step in the storage section when the address is not stored in the storage section (stores addresses in a destination table (Fig. 3)); and

an address designation step of designating an address selectively from addresses stored in the storage section when the other party of the facsimile communications is designated and setting the designated address as an address of the other party (CPU 5 designates an address from destination table of Fig. 3 and sets that destination to effect transmission to a communications partner, col. 10, lines 27-34).

### ***Allowable Subject Matter***

3. Claims 3, 6, and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

**Any response to this action should be mailed to:**

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Washington, DC 20231

**or Faxed to:**

(703) 872-9314 (for Technology Center 2600 only).

**Hand-delivered** responses should be brought to:

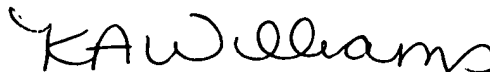
Crystal Park II

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Arlington, VA

Sixth Floor (Receptionist).

TJL



KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER